

REMARKS

The Office Action dated December 13, 2004 required restriction of the claims into three claim Groups. In response, Applicants elect Group II, namely claims 12-24, 38-50, and 64-74, which relates to generating data in a self-expanding data package.

However, Applicants do so with traverse. Applicants dispute the assertion by the Office that the three claim Groups involve separate and distinct inventions.

35 U.S.C. §121 provides that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." M.P.E.P. §802.01 deviates from the plain meaning of "independent and distinct" by interpreting "and" to mean "or". The Patent Office relies on the absence from the legislative history of anything contrary to this interpretation as support for their position that "and" means "or". Applicants respectfully note that this position is contrary to the rules of statutory construction. Restriction between two dependent inventions is not permissible under the plain meaning of 35 U.S.C. §121.

The Examiner does not assert that the inventions of the three claim Groups are independent. Rather, the Examiner alleges that the inventions of the three claim Groups are distinct because they are directed to a self-expanding data package, generating data in a self-expanding data package, and utilizing data in a self-expanding data package. Applicants assert that restriction is improper. Applicants note that claim 1 provides for a self-expanding data package containing a set of constant lists, row validation calculations, and expanding the package using such constant lists and calculations. Similarly, claim 12 provides for generating the self-expanding data package by stating what is in the data package. Namely, claim 12 provides for generating the values in the constant lists, and for generating calculations. Further, the claim provides for expanding the package using the constant lists and calculations. Similar to both claims 1 and 12, claim 25 provides for utilizing data in the self-expanding data package by receiving the package containing values in a set of constant lists and calculations. Further, the claim provides for expanding the package using the constant list and calculations.

Thus, all of the independent claims relate to and provide very similar limitations. In view of such similarities, separate searches would not be required. In this regard, Applicants urge the Examiner take into consideration that the subject matter of each of the claim Groups is linked by a common inventive concept. According to M.P.E.P. §803, there are two criteria for a proper

restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

Applicants assert that a search into prior art with regard to the invention of the different Groups is so related that separate significant search efforts should not be necessary. Accordingly, there is no serious burden on the Examiner to collectively examine the different claim Groups of the subject application. Therefore, restriction is not proper under M.P.E.P. §803.

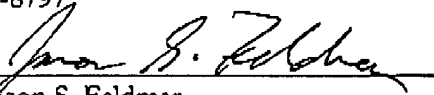
Consequently, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement. It is also submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: January 13, 2005

By: 
Name: Jason S. Feldmar
Reg. No.: 39,187

JSF/io

G&C 30566.203-US-01